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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/324,253	06/02/1999	JERRY C. CHEN	0050.1610-000	1283
207	7590	10/05/2005	EXAMINER	
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109			PAYNE, DAVID C	
			ART UNIT	PAPER NUMBER
			2638	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/324,253

Applicant(s)

CHEN, JERRY C.

Examiner

David C. Payne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-34 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14, 23, 24 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 15, 16, 28, 31, 33 and 34 is/are rejected.
- 7) ☒ Claim(s) 3-12, 17-22, 25, 26, 29, 30 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. Applicant's election without traverse of Species Figure 12C Subspecies 6C (electing claims 1, 2-12, 15-22, 25, 26, and 28-34) in the reply filed on 26 July 2005 is acknowledged.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 15, 16, 28, 31, 34 are rejected under 35 U.S.C. 102(b) as being anticipated by *Papen et al. US 5379310 A (Papen)* or *Johnson et al. US 5,493,426 (Johnson)* or *Patel et al. US 5,414,540 (Patel)*.

Re claims 1, 15, 16, 28, 31, 34, the prior art disclosed,

An optical device comprising:

a frequency dependent disperser that disperses an input optical signal to form a dispersed signal having a plurality of frequencies;

a frequency selective modulator that modulates at least one of the plurality of frequencies; and

a frequency dependent combiner that combines the frequencies in the dispersed signal to form an intensity modulated output signal.

(see e.g., Papen Figure 9, Johnson Figure 7, or Patel Figure 1)

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The preamble of the claim 1, 16, 28, 31, 34 respectively, "an optical frequency filter", "frequency modulation (FM) to intensity modulation (IM) converter", "method of convert FM signals to IM signals", "method of filtering", "method to shape transmission" has not been given patentable weight because clause found in the preamble of an apparatus claim is not afforded the effect of a distinguishing limitation unless the body of the claim sets forth structure which refers back to, is defined by, or otherwise draws life and breadth from the preamble. See *In re Casey*, 152 USPQ 235 (CCPA 1967); *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951). Thus a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See *Kropa V. Robie*, supra at 480. See also *EX parte Mott*, 190 USPQ 311, 313, (PTO BD of App. 1975).

4. Claims 1, 15, 16, 28, 31, 34 are rejected under 35 U.S.C. 102(e) as being anticipated by *Brock et al.* 5,870,216 (*Brock*).

Re claims 1, 15, 16, 28, 31, 34, *Brock* disclosed,

An optical device comprising:

a frequency dependent disperser that disperses an input optical signal to form a dispersed signal having a plurality of frequencies;

a frequency selective modulator that modulates at least one of the plurality of frequencies; and

a frequency dependent combiner that combines the frequencies in the dispersed signal to form an intensity modulated output signal.

(see e.g., Figure 7)

The preamble of the claim 1, 16, 28, 31, 34 respectively, "an optical frequency filter", "frequency modulation (FM) to intensity modulation (IM) converter", "method of convert FM signals to IM signals", "method of filtering", "method to shape transmission" has not been given patentable weight because clause found in the preamble of an apparatus claim is not afforded the effect of a distinguishing

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limitation unless the body of the claim sets forth structure which refers back to, is defined by, or otherwise draws life and breadth from the preamble. See *In re Casey*, 152 USPQ 235 (CCPA 1967); *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951). Thus a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See *Kropa V. Robie*, supra at 480. See also *EX parte Mott*, 190 USPQ 311, 313, (PTO BD of App. 1975).

***Allowable Subject Matter***

5. Claims 3-12, 17-22, 25, 26, 29, 30 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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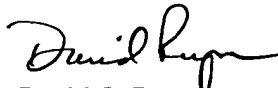
**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Payne whose telephone number is (571) 272-3024. The examiner can normally be reached on M-F, 7a-4p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Vanderpuye can be reached on (571) 272-3078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dcp

  
David C. Payne  
Patent Examiner  
AU 2638